

REMARKS

The Examiner has rejected the claims primarily on the basis of Applicant's own prior art, U.S. Patent No. 4,850,127. The application at hand contains three sets of claims headed by independent claims 1, 6 and 11. In each of these independent claims, it is submitted there are limitations that patentably distinguish these claims from the prior art.

The independent claims each require that the magazine port 12 have a rearward edge 39 with a non-beveled and non-radiused interior cornered edge 28. As indicated by the Examiner in the office action (paragraph 2, line 3), one of the differences between the invention at hand and the prior art device of Davis '127 is the shape of the rearward edge. The Examiner then states (paragraph 2, lines 4-6) that it would have been obvious to one of ordinary skill in the art to make the shape changes as claimed. It is respectfully submitted that this reasoning is not well founded.

As the Examiner is of course aware, the vast majority of patents are improvements or variations on devices disclosed in prior art. It is most rare for an application to involve a "Eureka" invention that is unrelated to earlier inventions. At issue in the examination is whether the improvement or variation is a patentable improvement or variation.

In the prior art of Davis '127 the only description as to the construction or design of the rearward edge of the magazine port is found in Figures 4 and 5, which clearly shows the rearward edge to be beveled. There is no language in the specification that provides any further or more detailed description of this element. Thus, the only teaching of the Davis '127 patent as to the shape of the rearward edge is that the rearward edge should be beveled. There is no teaching, suggestion or motivation (absent the hindsight of the disclosure at hand) that would

lead one of ordinary skill in the art to provide the rearward edge with a non-beveled and non-radiused interior cornered edge as required by the claims.

In fact, such a design would be counter-intuitive, since one of the goals of the magazine is to allow for rapid removal by spring ejection of the ammunition. One of ordinary skill would be more likely to assume, as Davis did in the 1989 patent, that providing a rearward edge with a beveled surface would more readily accomplish this goal, and that a non-beveled and non-radiused interior cornered edge may not be desirable. Only in addressing the problem of premature ejection of the shells, as explained in the specification of the application at hand, has it been determined that a non-beveled and non-radiused interior cornered edge improves the performance of the device. Given that in the 16 years since the Davis '127 patent issued, no one has improved upon the magazine in this manner, it is submitted that such improvement is novel and non-obvious.

Furthermore, independent claims 1 and 6 also include language defining the location of the interior cornered edge in relation to the ammunition retained therein. The Examiner has indicated that this is merely a matter of change in dimension and as such is not patentably distinct. It is again respectfully submitted that this conclusion is not properly reached in this case.

As the Examiner correctly states, a change in relative dimensions between a claimed device and a prior art device is considered obvious where the claimed device "would not perform differently than the prior art device" (paragraph 2, lines 6-9). However, as explained in the specification of the application at hand, the claimed device does perform differently than that of the prior art, in that premature ejection of ammunition is precluded in the claimed device. Thus, a problem inherent in the prior art device has been addressed and solved. Without the hindsight

offered by this disclosure, there is no teaching, suggestion or motivation to lead one of ordinary skill to adopt the claimed design as to dimensions. Again, the fact that for 16 years no one has addressed or solved this problem likewise speaks to its novelty and non-obviousness.

It is respectfully submitted that the claims as originally presented are patentable, on the basis of the above remarks, and reconsideration and subsequent passage for allowance is hereby requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas C. Saitta", with a stylized flourish at the end.

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